

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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| In re Application of: | § | Group Art Unit: 3692 |
| | § | |
| Nobuyoshi Morimoto | § | Examiner: Nguyen, Nga B |
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| | § | Atty. Dkt. No.: 5596-00301 |
| | § | |
| Serial No. 09/895,457 | § | |
| | § | |
| Filed: June 29, 2001 | § | |
| | § | |
| For: SYSTEM AND METHOD FOR | § | |
| NEGOTIATING IMPROVED | § | |
| TERMS FOR PRODUCTS AND | § | |
| SERVICES BEING PURCHASED | § | |
| THROUGH THE INTERNET | § | |

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir/Madam:

Further to the Notice of Appeal filed May 1, 2007 and in response to the Examiner's Answer of October 9, 2007, Appellant presents this Reply Brief.

ARGUMENT

Claims 1-44 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Lustig et al. (U.S. Publication 2002/0002531) (hereinafter “Lustig”) in view of Seymour et al. (U.S. Patent 6,871,190) (hereinafter “Seymour”). Appellant traverses this rejection for at least the following reasons. Different groups of claims are addressed under their respective subheadings.

Claims 1, 3, 4, 5, 6, 7, 9, 10, 13, 28, and 43:

1. The Examiner is improperly using Applicant’s specification, rather than using the plain meaning of the specific language of Applicant’s claim.

In regards to claim 1, Appellant has argued that Lustig in view of Seymour **fails to teach or suggest receiving information indicating one or more default purchasing standards for a purchaser using an Internet web site to purchase a product or service**. The Examiner’s position appears to be that a user selecting an offer in Lustig’s system inherently includes receiving information indicating default purchasing standards for the purchaser. Specifically, the Examiner’s Answer cites paragraphs 70-73 of Lustig and states, “the original offer and the [user] selected indicator is equivalent to the purchaser default settings as described in the Appellant’s Specification” (emphasis by Examiner, Examiner’s Answer, p. 10).

The Examiner is improperly ignoring the plain meaning of the language from Appellant’s claim and is instead relying on particular, hand-picked, phrases from Appellants’ specification to unnecessarily and improperly “define” the phrase “default purchasing standards” in Appellants’ claim.

As is described in the M.P.E.P. at 2111.01, “... the words of a claim **must** be given their plain meaning **unless** applicant has provided a clear definition in the specification.” *In re Zletz*, 893, F. 2d 319, 321, 13 USPQ 2d 1320, 1322 (Fed. Cir. 1989);

Chef America, Inc. v. Lamb-Weston, Inc., 358 F. 3d 1371, 1372, 69 USPQ 2d 1857 (Fed. Cir. 2004). Furthermore, “It is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language.” *In re Vogel*, 422 F. 2d 538, 441, 164 USPQ 619, 622 (CCPA 1970). In the present case, the Examiner is improperly using Appellant’s specification to interpret and define the language of Appellant’s claim.

Specifically, the Examiner has selected particular phrases from Appellants’ specification to define the term “default purchasing standards.” For example, the Examiner argues that Appellant’s specification describes default purchasing standards as only involving price comparison (Examiner’s Answer, p. 9, last paragraph), while ignoring the fact that the specification (in the same section as that relied on by the Examiner) also states “the default standards set the by purchaser may include such risk factors as whether the goods are perishable, a scarcity, or a good that carries product liabilities, such as chemicals” (Appellant’s Specification, p. 15, lines 20-25).

Thus, not only the Examiner improperly using Applicant’s Specification to define Applicant’s claim language, the Examiner is clearly relying only on particular portions of the specification while ignoring those portions that do not support the Examiner’s argument. Furthermore, the Examiner is overlooking the fact that Appellant’s claim (and specification) makes a clear distinction between simply committing to purchase a particular product or service and specifying default purchasing standards.

2. The cited art does not teach or suggest receiving information indicating one or more default purchasing standards for a purchaser using an Internet web site to purchase a product or service.

As noted above, Appellant argues that the cited art, whether considered singly or in combination **fails to teach or suggest receiving information indicating one or more default purchasing standards for a purchaser using an Internet web site to purchase a product or service.** As also noted above, the Examiner’s position appears to be that a

user selecting an offer in Lustig's system inherently includes receiving information indicating default purchasing standards for the purchaser. However, the Examiner is overlooking the fact that Appellant's claim (and specification) makes a clear distinction between simply committing to purchase a particular product or service and specifying default purchasing standards. In the passage of Lustig cited by the Examiner, Lustig teaches that his system provides a web page including a plurality of offers to the user for selection. Presenting a plurality of offers from which the user selects one in which he is interested does not equate to, nor imply, receiving information indicating one or more default purchasing standards, as recited in Appellant's claim. The user-selected offer to purchase an item in Lustig is not the same as receiving *default purchasing standards* that are distinct from terms associated with a commitment to purchase a product or service. An offer to purchase does not represent default purchasing standards (nor does accepting such an offer) and one of ordinary skill in the art would not equate a user-selection of an offer in Lustig with indicating or specifying default purchasing standards.

Moreover, the Examiner's line of reasoning is not substantiated by the actual teachings of Lustig. Lustig, even if combined with Seymour, does not teach anything suggesting that a user-selected offer has anything to do with default purchasing standards. Nor does Lustig (or Seymour) teach that selected offers are used in rejecting other offers that arise from the purchaser accepting a separate offer for negotiating improved terms within a specified time.

3. The cited art does not teach or suggest rejecting one or more of the plurality of offers based on the default purchasing standards.

In response to the Examiner's assertions that merely accepting one offer inherently includes rejecting one or more other offers, Appellant has argued that just because one offer is accepting, other offers are not automatically nor necessarily rejected. As noted above, Applicant's claim and specification make a clear distinction between accepting an offer and indicating default purchasing standards. The Examiner has not provided any rebuttal to Applicant's arguments regarding the fact that accepting one

offers does not inherently or necessarily include or suggest rejecting other offers. Furthermore, as noted above, the Examiner's reliance on the particular definition of "default purchasing standards" based on Appellant's specification is misplaced because the Examiner fails to use the plain meaning of the claim language.

Applicant has also argued that other (non-accepted) offers may be kept "open" or "alive" for any of various reasons (e. g., as a backup in case the original offer fails through). The Examiner has also failed to respond to this argument in the Examiner's Answer. Instead, the Examiner merely states how Lustig's program works (e.g., "Lustig teaches [that] the matching program ... retrieves the available offer ... compares the available offer with the original offer ... if the better offer is available, accepts the better offer on behalf of the user" (Examiner's Answer, pp 8-9). The Examiner then simply concludes, "by accepting the original offer, it is obvious that the matching program rejects the offers that do not [match] with the original offer", citing paragraphs 60-61 of Lustig. While the cited passage describes that Lustig's matching programs compares offers and accepts one (generally the better price), Lustig does not teach or suggest that the non-accepted offers are rejected.

The Examiner does not state any reason why one of ordinary skill would consider it obvious to specifically reject all other offers when accepting one offer. Instead, the Examiner merely states his own unsupported opinion that is obvious. Nor has the Examiner, even in response to Appellant's previous arguments, provided any evidentiary support of his opinion that accepting one offer "obviously includes" rejecting, as opposed to simply not accepting, the other offers.

Furthermore, the Examiner's logic does not make sense. According to the Examiner's interpretation a user in Lustig's system would never be able to accept more than one offer since after selecting one offer, the others would automatically be rejected. Such an interpretation cannot be correct.

Moreover, following the Examiner's line of reasoning, Lustig's system rejects other offers, not based on default purchasing standards but based on the simply fact of having accepting another offer. Thus, even according to the Examiner's interpretation, Lustig fails to teach or suggest rejecting other offers based on default purchasing standards, as recited in Appellant's claim.

4. The cited art does not teach or suggest in response to the purchaser accepting the offer, presenting one of a plurality of offers to the purchaser in response to the purchaser accepting a first offer, where the presented offer includes the improved terms.

Appellant has also argued that Lustig in view of Seymour fails to teach or suggest in response to the purchaser accepting the offer, presenting one of the plurality of offers to the purchaser where the presented offer includes the improved terms. Appellant has asserted that the Examiner's cited passage (paragraphs 42-44 of Lustig) cannot be said to teach presenting an offer including the improved terms in response to the purchaser accepting the offer, since Lustig clearly teaches that the user selects an offer AFTER the user is presented the web page including the offers (para. 44 and 70). At no time in Lustig's system is the user presented with another set of offers, whether or not they include the improved terms, in response to the user selecting the original offer.

In the Response to Arguments section of the Examiner's Answer, the Examiner fails to substantially respond to Appellant's arguments. Instead, the Examiner relies simply on the fact that Lustig's system will accept a better offer (than that selected by the user) on behalf of the user (Examiner's Answer, p 10). The Examiner then merely concludes, "Lustig does teach that the presented offer includes the improved terms" without specifically addressing any of Applicant's particular arguments.

However, Appellant is not arguing that Lustig in view of Seymour does not teach accepting an offer with better terms. Instead, as noted previously, Appellant's argument is that Lustig, even if combined with Seymour, does not *present an offer* to the user in

response to the user accepting an offer to purchase a product or service, where the presented offer includes the improved terms.

The Examiner has completely failed to provide any reasoning or evidence to support the contention that Lustig's system would present the "better offer" to the user (despite a lack of support in Lustig) and that such a presentation would necessarily include the improved terms. The Examiner does not explain how or why accepting an offer on behalf of the user necessarily includes presenting that offer to the user despite a complete lack of such teaching in Lustig.

5. The cited art teaches away from Appellant's claim.

Appellant has also argued that Lustig teaches away from this limitation as illustrated by paragraph 81 of Lustig (Appeal Brief, p. 14). Specifically, Appellant has argued that after a user has indicated an offer, if Lustig's system determines that a better offer is available, the matching program "accepts the actual better offer on behalf of the user." Nowhere does Lustig mention that the better offer is presented to the user. Instead, Lustig's system initially presents the user with a plurality of offer and in response to the user selecting one of the offers, accepts either that offer, or a better offer, "on behalf of the user" without presenting the additional, other offers to the user. The Examiner has failed to respond to this argument in the Examiner's Answer.

Moreover, "A *prima facie* case of obviousness can be rebutted if the applicant...can show that the art in any material respect 'taught away' from the claimed invention...A reference may be said to teach away when a person of ordinary skill, upon reading the reference...would be led in a direction divergent from the path that was taken by the applicant." *In re Haruna*, 249 F.3d 1327, 58USPQ2d 1517 (Fed. Cir. 2001).

Thus, for at least the reasons presented previously and above, the Examiner's rejection of claim 1 is improper and not supported by the cite art.

Claim 2:

1. The cited art does not teach or suggest all the limitations of Appellant's claim.

In regard to claim 2, Appellant has argued that Lustig in view of Seymour fails to teach or suggest wherein said detecting comprises detecting said purchaser entering a credit card number, a pre-paid account number, a gift certificate number, an escrow account number, or a bank guaranty number. The Examiner has cited paragraph [0047], which describes user information including payment information, such as a credit account number. However, nowhere does Lustig, even if combined with Seymour, teach or suggest that such user information is detected *as part of* detecting an issuance of a commitment to purchase with associated terms for said product or service being purchased, as argued in Appellant's Appeal Brief (p. 15).

In response, the Examiner argues, "Lustig teaches each user desiring to accept an offer ... has associated user information which is collected as part of [Lustig's] registration process" and that "the user information includes [a] credit card number", citing paragraph 47 of Lustig. The Examiner then concludes, "Lustig does teach wherein said detecting comprises detecting said purchaser entering a credit-card number" (Examiner's Answer, pp. 10-11).

However, the information on which the Examiner relies is not detected in Lustig's system as part of detecting an issuance of a commitment to purchase a product or service, as required by Appellant's claim. The Examiner is overlooking the fact that Lustig teaches collecting user registration information, including the credit card number relied on by the Examiner, "as part of the user registration process in which each user is required to provide the user registration information before being presented with offers" (emphasis added, Lustig, paragraph 47). Moreover, the Examiner appears to acknowledge the fact that a user's credit card information is collected during Lustig's

registration process before any offers are presented to the user regarding the rejection of claim 8 (Examiner Examiner's Answer, p. 11). Thus, there is simply no way that Lustig's collection of user registration information (including credit card numbers) can be considered pat of detecting the user's selection of an offer that hasn't even been presented to the user.

2. The cited art teaches from Appellant's claim.

As noted above, Lustig states that his system *requires* the user to complete the registration process, including the collection of credit card information, prior to being presented any offers. Thus, by teaching the collection of such payment information as credit card numbers during a registration process that Lustig specifically teaches is required to be preformed before a user is presented any offers, Lustig clearly TEACHES AWAY from Appellant's claim.

Claim 8

The cited art does not teach or suggest all the limitations of Appellant's claim.

In regard to claim 8, Appellants have argued that Lustig in view of Seymour fails to teach or suggest wherein said commitment to purchase comprises a purchase order for which payment has been guaranteed by said purchaser. The Examiner has cited paragraph [0047] of Lustig, which describes user information including payment information. However, as noted above regarding the rejection of claim 2, and as admitted by the Examiner, Lustig's system requires a user to complete the registration process, including the collection of payment information, such as credit card information, before the user is presented with any offers (Lustig, paragraph 47 and Examiner's Answer, p 11). Appellant's have noted that nowhere does Lustig teach or suggest anything at all about a purchase order for which payment has been guaranteed by said purchaser, much less *wherein said commitment to purchase comprises a purchase order for which payment has been guaranteed by said purchaser*.

In response, the Examiner submits, “Lustig teaches that the user is required to submit account information include[ing] credit card number ... before being presented with the offers (Examiner’s Answer, p. 11). Thus, the Examiner acknowledges that Lustig requires the entering payment info prior to the user seeing any offers. The Examiner further asserts that a user in Lustig’s system “submit[s] payment information before submitting a purchase order.” However, Lustig makes no mention of a purchase order. The Examiner is simply speculating that use of a purchase order is somehow included in Lustig’s system without providing any reasoning or evidence to support such speculation.

Moreover, the Examiner is overlooking the plain language of Appellant’s claim. Appellant is not claiming merely some general or generic use of a purchase order. Instead, claim 8 recites, in part, that a commitment to purchase a product or service includes a purchase order for which payment has been guaranteed by the purchaser. However, the Examiner has failed to provide any evidence or reasoning as to why, in the absence of any teaching by Lustig or Seymour, the user selecting an offer from a web page (as relied on by the Examiner as a commitment to purchase) would necessarily include a purchase order for which payment has been guaranteed by the purchaser.

It simply does not follow that a user selecting an indicator “that serves as a label for the hypertext link, indicating that the indicator is selected ... by way of a singular action by the User” (Lustig, para. 72) represents an issuance of a commitment to purchase the product or service including a purchase order for which payment has been guaranteed by the purchaser.

2. The cited art teaches from Appellant’s claim.

As noted above, Lustig states that his system *requires* the user to complete the registration process, including the collection of credit card information, prior to being presented any offers. Thus, by teaching the collection of such payment information as

credit card numbers during a registration process that Lustig specifically teaches is required to be preformed before a user is presented any offers, Lustig clearly **teaches away** from Appellant's claim.

Claim 11

1. The cited art fails to teach or suggest all the limitations of Appellant's claim.

In regard to claim 11, Appellant has argued **Lustig fails to teach or suggest wherein conducting said search for said improved terms comprises conducting an auction amongst a plurality of suppliers for said product.** Specifically, Appellant has argued that the Examiner's reliance on Lustig, including the passage cited by the Examiner (para. 78) is misplaced since Lustig does not teach or suggest anything about conducting a search for improved terms that includes conducting an auction amongst suppliers. Instead, Lustig teaches accessing "the available offer information in the matching database 270," comparing "the available offer information with the original offer information to determine whether the better offer is available" (para. 78). However, as argued in Applicant's Appeal Brief, merely comparing previously stored offers from a database does not teach, suggest, or imply conducting an auction amongst suppliers.

In response, the Examiner again relies on Lustig's system comparing offers from database 270. The Examiner argues that by comparing available offers from a database "[Lustig's] matching engine conducts an auction amongst a plurality of vendors" (Examiner's Answer, pp 11-12). Thus, the Examiner apparently equates comparing previously recorded offers with the specific limitation of conducting an auction amongst a plurality of suppliers. However, the Examiner fails to explain, even in response to Appellant's argument in the Appeal Brief, how merely comparing offers stored in a database can be considered conducting an auction. Lustig does not describe comparing the offers in matching database 270 as having anything to do with conducting an auction.

Instead, Lustig specifically teaches that matching database 270 "organizes, stores

and retrieves information that describes a plurality of available offers made by one or more vendors” and that “matching database 270 can be the ‘Order Book’” (Lustig, para. 56). One of ordinary skill in the art would not consider the comparison of offers in a database or “order book” as conducting an auction among suppliers. Following the Examiner’s logic, a person selecting an item out of a mail order catalog would also necessarily involve conducting an auction amongst all the suppliers in the catalog. The Examiner’s interpretation is clearly incorrect.

Claim 12

The cited art does not teach or suggest all the limitations of Appellant’s claim

In regard to claim 12, Appellant has argued that **Lustig in view of Seymour fails to teach or suggest entering a legal contract with said purchaser to supply said product under said improved terms.** The Examiner cited paragraph 79, reproduced in Appellant’s appeal Brief (p. 17). However, as Appellant has argued, Lustig fails to mention anything at all about entering a legal contract with the purchaser to supply the product under the improved terms. Instead, Lustig teaches accepting a better offer or an original offer on behalf of the user. Lustig does not describe accepting an offer as including entering a legal contract with the purchaser to supply the product under the improved terms. Entering a contract to supply a product under an original set of terms does not imply entering a contract to supply the product at improved terms. Even if Lustig’s system will accept a better offer if one is available, Lustig’s system does not enter into a legal contract to supply the product at the improved terms.

In response, the Examiner argues, “Lustig teaches the order server forwards an indication to the user’s computer that the user confirms to accept the original offer when the better offer is not available, and the completion of the transaction in accordance with the parameters of the original offer” citing paragraph 87 of Lustig. Thus, the Examiner is relying on the fact that Lustig’s system obtains the user’s acceptance of the “original offer” when the better offer is not available. Appellant fails to see how accepting the

original offer has anything to do with entering a legal contract with the purchaser to supply the product *under improved terms*, as recited in Appellant's claim. Clearly, accepting the original offer does not involve or include the improved terms.

Furthermore, since in Lustig, the matching program has not even search for and compared the other offers in the matching database 270, any improved terms would not be known when the user is accepting the original offer. Thus, there is simply no way that a user accepting Lustig's original offer can be considered entering a legal contract with the purchaser to supply the product under the improved terms.

Claims 14, 16, 17, 18, 19, 20, 22, 23, 26, and 27

1. The Examiner is improperly using Applicant's specification, rather than using the plain meaning of the specific language of Applicant's claim.

In regards to claim 14, Appellant has argued that Lustig in view of Seymour **fails to teach or suggest receiving information indicating one or more default purchasing standards for a purchaser using an Internet web site to purchase a product or service**. The Examiner's position appears to be that a user selecting an offer in Lustig's system inherently includes receiving information indicating default purchasing standards for the purchaser. Specifically, the Examiner's Answer cites paragraphs 70-73 of Lustig and states, "the original offer and the [user] selected indicator is equivalent to the purchaser default settings as described in the Appellant's Specification" (emphasis by Examiner, Examiner's Answer, p. 10).

In the response to Arguments, the Examiner does not provide any specific responses regarding claim 14, but relies on responses to Appellant's arguments regarding claim 1.

As noted above regarding the rejection of claim 1, the Examiner is improperly ignoring the plain meaning of the language from Appellant's claim and is instead relying

on particular, hand-picked, phrases from Appellants' specification to unnecessarily and improperly "define" the phrase "default purchasing standards" in Appellants' claim. Specifically, the Examiner has selected particular phrases from Appellants' specification to define the term "default purchasing standards." The Examiner is also clearly relying only on particular portions of the specification while ignoring those portions that do not support the Examiner's argument. Furthermore, the Examiner is overlooking the fact that Appellant's claim (and specification) makes a clear distinction between simply committing to purchase a particular product or service and specifying default purchasing standards. Please refer to Appellant's remarks regarding claim 1 above, as they apply to the rejection of claim 14 as well.

2. The cited art does not teach or suggest receiving information indicating one or more default purchasing standards for a purchaser using an Internet web site to purchase a product or service.

As noted above, Appellant argues that the cited art, whether considered singly or in combination **fails to teach or suggest receiving information indicating one or more default purchasing standards for a purchaser using an Internet web site to purchase a product or service.** As also noted above, the Examiner's position appears to be that a user selecting an offer in Lustig's system inherently includes receiving information indicating default purchasing standards for the purchaser. The Examiner is further overlooking for fact that Appellant's claim (and specification) makes a clear distinction between simply committing to purchase a particular product or service and specifying default purchasing standards.

Lustig teaches that his system provides a web page including a plurality of offers to the user for selection. The user-selected offer to purchase an item in Lustig is not the same as receiving *default purchasing standards* that are distinct from terms associated with a commitment to purchase a product or service. An offer to purchase does not represent default purchasing standards (nor does accepting such an offer) and one of

ordinary skill in the art would not equate a user-selection of an offer in Lustig with indicating or specifying default purchasing standards.

Please also refer to Appellant's remarks regarding claim 1 above, as they apply to the rejection of claim 14 as well.

3. The cited art does not teach or suggest rejecting one or more of the plurality of offers based on the default purchasing standards.

In response to the Examiner's assertions that merely accepting one offer inherently includes rejecting one or more other offers, Appellant has argued that just because one offer is accepting, other offers are not automatically nor necessarily rejected. As noted previously, Applicant's claim and specification make a clear distinction between accepting an offer and indicating default purchasing standards. The Examiner has not provided any rebuttal to Applicant's arguments regarding the fact that accepting one offers does not inherently or necessarily include or suggest rejecting other offers. Furthermore, as noted above, the Examiner's reliance on the particular definition of "default purchasing standards" based on Appellant's specification is misplaced because the Examiner fails to use the plain meaning of the claim language.

Applicant has also argued that other (non-accepted) offers may be kept "open" or "alive" for any of various reasons (e. g., as a backup in case the original offer fails through). The Examiner has also failed to respond to this argument in the Examiner's Answer. Instead, the Examiner argues, "by accepting the original offer, it is obvious that the matching program rejects the offers that do not [match] with the original offer", citing paragraphs 60-61 of Lustig. While the cited passage describes Lustig's matching programs comparing offers and accepts one (generally the better price), Lustig does not teach or suggest that the non-accepted offers are rejected. The Examiner does not state any reason why one of ordinary skill would consider it obvious to specifically reject all other offers when accepting one offer. Instead, the Examiner merely states the opinion that is obvious. Nor has the Examiner, even in response to Appellant's previous

arguments, provided any evidentiary evidence to support the opinion that accepting one offer “obviously includes” rejecting, as opposed to simply not accepting, the other offers.

Moreover, following the Examiner’s line of reasoning, Lustig’s system rejects other offers, not based on default purchasing standards but based on the simply fact of having accepting another offer. Thus, even according to the Examiner’s interpretation, Lustig fails to teach or suggest rejecting other offers based on default purchasing standards, as recited in Appellant’s claim.

Please refer to Appellant’s remarks regarding claim 1 above, as they apply to the rejection of claim 14 as well.

4. The cited art does not teach or suggest in response to the purchaser accepting the offer, presenting one of a plurality of offers to the purchaser in response to the purchaser accepting a first offer, where the presented offer includes the improved terms.

Appellant has also argued that Lustig in view of Seymour fails to teach or suggest in response to the purchaser accepting the offer, presenting one of the plurality of offers to the purchaser where the presented offer includes the improved terms. Appellant has asserted that the Examiner’s cited passage (paragraphs 42-44 of Lustig) cannot be said to teach presenting an offer including the improved terms in response to the purchaser accepting the offer, since Lustig clearly teaches that the user selects an offer AFTER the user is presented the web page including the offers (para. 44 and 70). At no time in Lustig’s system is the user presented with another set of offers, whether or not they include the improved terms, in response to the user selecting the original offer.

In the Response to Arguments section of the Examiner’s Answer (regarding claim 1), the Examiner fails to substantially respond to Appellant’s arguments. Instead, the Examiner relies simply on the fact that Lustig’s system will accept a better offer (than that selected by the user) on behalf of the user (Examiner’s Answer, p 10). The Examiner

then merely concludes, “Lustig does teach that the presented offer includes the improved terms” without specifically addressing any of Applicant’s particular arguments.

The Examiner has completely failed to provide any reasoning or evidence to support the contention that Lustig’ system would present the “better offer” to the user (despite a lack of support in Lustig) and that such a presentation would necessarily include the improved terms. The Examiner does not explain how or why accepting an offer on behalf of the user necessarily includes presenting that offer to the user despite a complete lack of such teaching in Lustig.

Please refer to Appellant’s remarks regarding claim 1 above, as they apply to the rejection of claim 14 as well.

5. The cited art teaches away from Appellant’s claim.

Appellant has also argued that Lustig teaches away from this limitation as illustrated by paragraph 81 of Lustig (Appeal Brief, p. 14). Specifically, Appellant has argued that after a user has indicated an offer, if Lustig’s system determines that a better offer is available, the matching program “accepts the actual better offer on behalf of the user.” Nowhere does Lustig mention that the better offer is presented to the user. Instead, Lustig’s system initially presents the user with a plurality of offer and in response to the user selecting one of the offers, accepts either that offer, or a better offer, “on behalf of the user” without presenting the additional, other offers to the user. The Examiner has failed to respond to this argument in the Examiner’s Answer.

Please refer to Appellant’s remarks regarding claim 1 above, as they apply to the rejection of claim 14 as well.

Claim 15

1. The cited art does not teach or suggest all the limitations of Appellant's claim.

In regard to claim 15, Appellant has argued that Lustig in view of Seymour fails to teach or suggest wherein said computer program is configured to detect the issuance of the commitment to purchase by detecting said purchaser entering a credit card number or a pre-paid account number or a gift certificate number. In the response to Arguments, the Examiner does not provide any specific responses regarding claim 15, but relies on responses to Appellant's arguments regarding claim 2. As such, please refer to Applicant's remarks above regarding the rejection of claim 2, which will be summarized below.

The Examiner has cited paragraph [0047], which describes user information including payment information, such as a credit account number. However, nowhere does Lustig, even if combined with Seymour, teach or suggest that such user information is detected *as part of* detecting an issuance of a commitment to purchase with associated terms for said product or service being purchased, as argued in Appellant's Appeal Brief (p. 15).

In response, the Examiner argues (regarding claim 2), "Lustig teaches each user desiring to accept an offer ... has associated user information which is collected as part of [Lustig's] registration process" and that "the user information includes [a] credit card number", citing paragraph 47 of Lustig. The Examiner then concludes, "Lustig does teach wherein said detecting comprises detecting said purchaser entering a credit-card number" (Examiner's Answer, pp. 10-11).

However, the information on which the Examiner relies is not detected in Lustig's system as part of detecting an issuance of a commitment to purchase a product or service, as required by Appellant's claim. The Examiner is overlooking the fact that Lustig teaches collecting user registration information, including the credit card number

relied on by the Examiner, “as part of the user registration process in which each user is required to provide the user registration information before being presented with offers” (emphasis added, Lustig, paragraph 47). Moreover, the Examiner appears to acknowledge the fact that a user’s credit card information is collected during Lustig’s registration process before any offers are presented to the user regarding the rejection of claim 8 (Examiner Examiner’s Answer, p. 11). Thus, there is simply no way that Lustig’s collection of user registration information (including credit card numbers) can be considered pat of detecting the user’s selection of an offer that hasn’t even been presented to the user.

2. The cited art teaches from Appellant’s claim.

As noted above, Lustig states that his system *requires* the user to complete the registration process, including the collection of credit card information, prior to being presented any offers. Thus, by teaching the collection of such payment information as credit card numbers during a registration process that Lustig specifically teaches is required to be preformed before a user is presented any offers, Lustig clearly TEACHES AWAY from Appellant’s claim.

Claim 21

The cited art does not teach or suggest all the limitations of Appellant’s claim.

In regard to claim 21, Appellants have argued that Lustig in view of Seymour fails to teach or suggest wherein said commitment to purchase comprises a purchase order for which payment has been guaranteed by said purchaser. In the Examiner’s Answer, the Examiner does not provide any specific responses regarding claim 21, but relies on responses to Appellant’s arguments regarding claim 8. As such, please refer to Applicant’s remarks above regarding the rejection of claim 8, which will be summarized below.

The Examiner has cited paragraph [0047] of Lustig, which describes user information including payment information. However, as noted above regarding the rejection of claim 2, and as admitted by the Examiner, Lustig's system requires a user to complete the registration process, including the collection of payment information, such as credit card information, before the user is presented with any offers (Lustig, paragraph 47 and Examiner's Answer, p 11). Appellant's have noted that nowhere does Lustig teach or suggest anything at all about a purchase order for which payment has been guaranteed by said purchaser, much less *wherein said commitment to purchase comprises a purchase order for which payment has been guaranteed by said purchaser*.

In response, the Examiner submits, "Lustig teaches that the user is required to submit account information include[ing] credit card number ... before being presented with the offers (Examiner's Answer, p. 11). Thus, the Examiner acknowledges that Lustig requires the entering payment info prior to the user seeing any offers. The Examiner further asserts that a user in Lustig's system "submit[s] payment information before submitting a purchase order." However, Lustig makes no mention of a purchase order. The Examiner is simply speculating that use of a purchase order is somehow included in Lustig's system without providing any reasoning or evidence to support such speculation.

Moreover, the Examiner is overlooking the plain language of Appellant's claim. Appellant is not claiming merely some general or generic use of a purchase order. Instead, claim 21 recites, in part, that a commitment to purchase a product or service includes a purchase order for which payment has been guaranteed by the purchaser. However, the Examiner has failed to provide any evidence or reasoning as to why, in the absence of any teaching by Lustig or Seymour, the user selecting an offer from a web page (as relied on by the Examiner as a commitment to purchase) would necessarily include a purchase order for which payment has been guaranteed by the purchaser.

It simply does not follow that a user selecting an indicator "that serves as a label for the hypertext link, indicating that the indicator is selected ... by way of a singular

action by the User” (Lustig, para. 72) represents an issuance of a commitment to purchase the product or service including a purchase order for which payment has been guaranteed by the purchaser.

Claim 24

1. The cited art fails to teach or suggest all the limitations of Appellant’s claim.

In regard to claim 24, Appellant has argued that **Lustig fails to teach or suggest wherein conducting said search for said improved terms comprises conducting an auction amongst a plurality of suppliers for said product.** In the Examiner’s Answer, the Examiner does not provide any specific responses regarding claim 24, but relies on responses to Appellant’s arguments regarding claim 11. As such, please refer to Applicant’s remarks above regarding the rejection of claim 11, which will be summarized below.

Appellant has argued that the Examiner’s reliance on Lustig, including the passage cited by the Examiner (para. 78) is misplaced since Lustig does not teach or suggest anything about conducting a search for improved terms that includes conducting an auction amongst suppliers. Instead, Lustig teaches accessing “the available offer information in the matching database 270,” comparing “the available offer information with the original offer information to determine whether the better offer is available” (para. 78). However, as argued in Applicant’s Appeal Brief, merely comparing previously stored offers from a database does not teach, suggest, or imply conducting an auction amongst suppliers.

In response, the Examiner (regarding claim 11) relies on Lustig’s system comparing offers from database 270. The Examiner argues that by comparing available offers from a database “[Lustig’s] matching engine conducts an auction amongst a plurality of vendors” (Examiner’s Answer, pp 11-12). Lustig specifically teaches that matching database 270 “organizes, stores and retrieves information that describes a

plurality of available offers made by one or more vendors” and that “matching database 270 can be the ‘Order Book’” (Lustig, para. 56). One of ordinary skill in the art would not consider the comparison of offers in a database or “order book” as conducting an auction among suppliers. However, the Examiner fails to explain, even in response to Appellant’s argument in the Appeal Brief, how merely comparing offers stored in a database can be considered conducting an auction. Lustig does not describe comparing the offers in matching database 270 as having anything to do with conducting an auction. Following the Examiner’s logic, a person selecting an item out of a mail order catalog would also necessarily involve conducting an auction amongst all the suppliers in the catalog. The Examiner’s interpretation is clearly incorrect.

While Seymour does disclose a “system and method for conducting an electronic auction over an open communications network,” **the Examiner fails to provide any reason at all as to why one of ordinary skill in the art would be motivated to combine the teachings of Seymour with the teachings of Lustig to create the specific method of claim 24.**

Thus, for at least the reasons presented above, the rejection of claim 24 is unsupported by the cited art and removal thereof is respectfully requested.

Claim 25

The cited art does not teach or suggest all the limitations of Appellant’s claim

In regard to claim 25, Appellant has argued that **Lustig in view of Seymour fails to teach or suggest wherein the web site server is operable to enter into a legal contract with said purchaser to supply said product under said improved terms.** In the Examiner’s Answer, the Examiner does not provide any specific responses regarding claim 25, but relies on responses to Appellant’s arguments regarding claim 12. As such, please refer to Applicant’s remarks above regarding the rejection of claim 12, which will be summarized below.

Appellant has argued that Lustig fails to mention anything at all about entering a legal contract with the purchaser to supply the product under the improved terms. Instead, Lustig teaches accepting a better offer or an original offer on behalf of the user. Lustig does not describe accepting an offer as including entering a legal contract with the purchaser to supply the product under the improved terms. Entering a contract to supply a product under an original set of terms does not imply entering a contract to supply the product at improved terms. Even if Lustig's system will accept a better offer if one is available, Lustig's system does not enter into a legal contract to supply the product at the improved terms.

In response, the Examiner argues (regarding claim 12), "Lustig teaches the order server forwards an indication to the user's computer that the user confirms to accept the original offer when the better offer is not available, and the completion of the transaction in accordance with the parameters of the original offer" citing paragraph 87 of Lustig. Thus, the Examiner is relying on the fact that Lustig's system obtains the user's acceptance of the "original offer" when the better offer is not available. Appellant fails to see how accepting the original offer has anything to do with entering a legal contract with the purchaser to supply the product *under improved terms*, as recited in Appellant's claim. Clearly, accepting the original offer does not involve or include the improved terms.

Furthermore, since in Lustig, the matching program has not even search for and compared the other offers in the matching database 270, any improved terms would not be known when the user is accepting the original offer. Thus, there is simply no way that a user accepting Lustig's original offer can be considered entering a legal contract with the purchaser to supply the product under the improved terms.

Claims 29, 32, 33, 34, 35, 37, 39, and 40

1. The cited art does not teach or suggest that if a better price is found before the predetermined amount of time expires, purchasing the particular item or service for the purchaser at the better price and *charging the purchaser a new price between the particular price and the better price.*

Regarding claims 29, Appellants have argued that Lustig in view of Seymour fail to teach or suggest that if a better price is found before the predetermined amount of time expires, purchasing the particular item or service for the purchaser at the better price and *charging the purchaser a new price between the particular price and the better price.* Appellant has also argued that **the Examiner does not provide a proper rejection of claim 29.** Instead, the Examiner relies on the rejection of claims 1-13. However as noted in Appellant's Appeal Brief, none of claims 1-13, nor of their rejections, mentions anything about purchasing an item or service for a purchaser at a better price and charging the purchaser a new price between the particular price and the better price.

In response to Appellant's previous arguments, the Examiner refers to the fact that Lustig's system may accept a better offer (better than the user's originally selected offer) on behalf of the user. The Examiner then assert, "Lustig obviously teaches purchasing the particular item [or] service for the purchaser [at] the better price and charging the purchaser a new price between the particular price and the better [price]" (Examiner's Answer, p. 13).

However, the Examiner's assertion is completely unsupported by the actual teachings of the cited references. Nowhere does Lustig, even in light of Seymour, teach anything about purchasing an item for a better price and charging the user a new price between the original price and the better price.

Lustig's system may accept an offer that is priced between an original offer and a third offer that is unacceptable (or unavailable) for some reason. For instance, the

Examiner describes a hypothetical scenario in which a second offer is priced lower than the original offer but higher than a third offer. In the Examiner's scenario, the third offer is unacceptable and thus Lustig's system would accept the second offer on behalf of the user. The Examiner's reasoning is thus that since the second offer's price is between that the first and third offers, Lustig's system would then charge the user a price between the first offer (e.g., the original) and the third offer. See the Examiner's Answer, p. 13.

The Examiner is overlooking the fact that Appellant's claim recites that the new price is between the original price and the price of the accepted offer (e.g., "purchasing the particular item or service for the purchaser at the better price and charging the purchaser a new price between said particular price and said better price"). In contrast, in the Examiner's hypothetical scenario, Lustig's system would purchase the product at the price of the second offer and would charge the user the same price (of the second offer). The fact that another, unacceptable offer may have an even lower price has no bearing on how Lustig's system would purchase a product on behalf of the user.

2. The cited art teaches from Appellant's claim.

Furthermore, Lustig **teaches away** from purchasing the product at the better price and charging the purchaser a new price between the original price and the better price. For instance, as admitted by the Examiner, Lustig teaches that his system "accepts the better offer on behalf of the user" (Lustig, paragraphs 9, 19, 25 and 81). Accepting a better offer on behalf of the user clearly implies that the better offer, and hence the cost or price of the better offer is accepted on behalf of the user. In contrast Appellant's claim specifically recites charging a new price between the particular price and the better price. By accepting the better offer, and hence the better price, "on behalf of the user" Lustig clearly **teaches away** from Appellant's claimed subject matter.

Claim 30

1. The Examiner has failed to provide a *prima facie* rejection.

Regarding claim 30, as argued in Appellant's Appeal Brief, **the Examiner does not provide a proper rejection of claim 30.** Instead, the Examiner relies on the rejections of claims 1-13. However, none of claims 1-13, nor their rejections, mentions anything regarding this limitation. The Examiner has improperly failed to consider the specific limitations of Appellant's claim. Therefore, no *prima facie* rejection has been stated in regard to claim 30. The Examiner has failed to respond to this argument or to provide a *prima facie* rejection of claim 30. See the Examiner's Answer, p. 7, last paragraph and p. 13).

2. The cited art fails to teach or suggest all the limitations of Appellant's claim.

Appellant has argued that **Lustig in view of Seymour fails to teach or suggest wherein if said original purchase is not available after said searching is complete, purchasing said particular item for said purchaser at another price and charging the purchaser said particular price.** In response, the Examiner argues, "Lustig teaches after searching and comparing the Second Offer with the available offers, the matching program determines that the better offer is not available, the matching program accepts the Second Offer with the Second Price" citing paragraphs 85-86 (Examiner's Answer, p. 13). However, the Examiner's interpretation of Lustig is clearly incorrect. The cited paragraph states that Lustig's system will select the better offer and accept that offer on behalf of the user.

For example, paragraph 85 states, "if the matching program 60 determines that the better offer is not available and if ... the second offer is the original offer, the matching program 260 accepts the original offer on behalf of the user." Paragraph 86 teaches that Lustig's matching program 260 will accept the second offer on behalf of the user "if the user has selected the indicator adjacent to the second offer" and that if the matching

program determines “that the better offer is not available (e.g., the second price is lower than the third price)” Lustig’s system “will accept the second offer on behalf of the user.” Thus, both passages cited by the Examiner refer to accepting the original offer if the better offer is not available. Lustig is completely silent on the original offer not being available after searching and comparing the other available offers.

3. The cited art teaches away from Appellant’s claim.

Appellant has also argued that **Lustig in view of Seymour appears to teach away from wherein if said original purchase is not available after said searching is complete, purchasing said particular item for said purchaser at another price and charging the purchaser said particular price.** As admitted by the Examiner, Lustig teaches that his system, “accepts the better offer on behalf of the User” (para. 9, 15, 25, 19 and 81). Accepting a better offer *on behalf of the user* clearly implies that the better offer, and hence the cost or price of the better offer, is accepted by Lustig’s system for the user. In contrast, Appellant’s claim specifically recites purchasing said particular item for said purchaser at another price and charging the purchaser said particular price. **Nowhere does Lustig, even when combined with Seymour, teach or suggest charging a purchaser a price that is different than a price at which a particular item was purchased.**

Claim 31

1. The cited art does not teach or suggest all the limitations of Appellant’s claim.

In regard to claim 31, Appellant has argued that Lustig in view of Seymour fails to teach or suggest fails to teach or suggest wherein said detecting *comprises* detecting said purchaser entering a credit card number or a pre-paid account number or a gift certificate number. In the response to Arguments, the Examiner does not provide any specific responses regarding claim 31, but relies on responses to

Appellant's arguments regarding claim 2. As such, please refer to Applicant's remarks above regarding the rejection of claim 2, which will be summarized below.

The Examiner has cited paragraph [0047], which describes user information including payment information, such as a credit account number. However, nowhere does Lustig, even if combined with Seymour, teach or suggest that such user information is detected *as part of* detecting an issuance of a commitment to purchase with associated terms for said product or service being purchased, as argued in Appellant's Appeal Brief (p. 15).

In response, the Examiner argues (regarding claim 2), "Lustig teaches each user desiring to accept an offer ... has associated user information which is collected as part of [Lustig's] registration process" and that "the user information includes [a] credit card number", citing paragraph 47 of Lustig. The Examiner then concludes, "Lustig does teach wherein said detecting comprises detecting said purchaser entering a credit-card number" (Examiner's Answer, pp. 10-11).

However, the information on which the Examiner relies is not detected in Lustig's system as part of detecting an issuance of a commitment to purchase a product or service, as required by Appellant's claim. The Examiner is overlooking the fact that Lustig teaches collecting user registration information, including the credit card number relied on by the Examiner, "as part of the user registration process in which each user is required to provide the user registration information before being presented with offers" (emphasis added, Lustig, paragraph 47). Moreover, the Examiner appears to acknowledge the fact that a user's credit card information is collected during Lustig's registration process before any offers are presented to the user regarding the rejection of claim 8 (Examiner's Answer, p. 11). Thus, there is simply no way that Lustig's collection of user registration information (including credit card numbers) can be considered part of detecting the user's selection of an offer that hasn't even been presented to the user.

2. The cited art teaches from Appellant's claim.

As noted above, Lustig states that his system *requires* the user to complete the registration process, including the collection of credit card information, prior to being presented any offers. Thus, by teaching the collection of such payment information as credit card numbers during a registration process that Lustig specifically teaches is required to be preformed before a user is presented any offers, Lustig clearly **teaches away** from Appellant's claim.

Claim 36

The cited art does not teach or suggest all the limitations of Appellant's claim.

In regard to claim 36, Appellants have argued that Lustig in view of Seymour fails to teach or suggest wherein said original purchase comprises a purchase order for which payment has been guaranteed by said purchaser. In the Examiner's Answer, the Examiner does not provide any specific responses regarding claim 36, but relies on responses to Appellant's arguments regarding claim 8. As such, please refer to Applicant's remarks above regarding the rejection of claim 8, which will be summarized below.

The Examiner has cited paragraph [0047] of Lustig, which describes user information including payment information. However, as noted above regarding the rejection of claim 2, and as admitted by the Examiner, Lustig's system requires a user to complete the registration process, including the collection of payment information, such as credit card information, before the user is presented with any offers (Lustig, paragraph 47 and Examiner's Answer, p 11). Appellant's have noted that nowhere does Lustig teach or suggest anything at all about a purchase order for which payment has been guaranteed by said purchaser, much less *wherein said commitment to purchase comprises a purchase order for which payment has been guaranteed by said purchaser*.

In response, the Examiner submits, “Lustig teaches that the user is required to submit account information include[ing] credit card number ... before being presented with the offers (Examiner’s Answer, p. 11). Thus, the Examiner acknowledges that Lustig requires the entering payment info prior to the user seeing any offers. The Examiner further asserts that a user in Lustig’s system “submit[s] payment information before submitting a purchase order.” However, Lustig makes no mention of a purchase order. The Examiner is simply speculating that use of a purchase order is somehow included in Lustig’s system without providing any reasoning or evidence to support such speculation.

Moreover, the Examiner is overlooking the plain language of Appellant’s claim. Appellant is not claiming merely some general or generic use of a purchase order. Instead, claim 36 recites, in part, that a commitment to purchase a product or service includes a purchase order for which payment has been guaranteed by the purchaser. However, the Examiner has failed to provide any evidence or reasoning as to why, in the absence of any teaching by Lustig or Seymour, the user selecting an offer from a web page (as relied on by the Examiner as a commitment to purchase) would necessarily include a purchase order for which payment has been guaranteed by the purchaser.

It simply does not follow that a user selecting an indicator “that serves as a label for the hypertext link, indicating that the indicator is selected ... by way of a singular action by the User” (Lustig, para. 72) represents an issuance of a commitment to purchase the product or service including a purchase order for which payment has been guaranteed by the purchaser.

Claim 38

1. The cited art fails to teach or suggest all the limitations of Appellant’s claim.

In regard to claim 38, Appellant has argued that **Lustig fails to teach or suggest wherein searching for said better price comprises conducting an auction amongst a**

plurality of suppliers for said product. In the Examiner's Answer, the Examiner does not provide any specific responses regarding claim 38, but relies on responses to Appellant's arguments regarding claim 11. As such, please refer to Applicant's remarks above regarding the rejection of claim 11, which will be summarized below.

Appellant has argued that the Examiner's reliance on Lustig, including the passage cited by the Examiner (para. 78) is misplaced since Lustig does not teach or suggest anything about conducting a search for improved terms that includes conducting an auction amongst suppliers. Instead, Lustig teaches accessing "the available offer information in the matching database 270," comparing "the available offer information with the original offer information to determine whether the better offer is available" (para. 78). However, as argued in Applicant's Appeal Brief, merely comparing previously stored offers from a database does not teach, suggest, or imply conducting an auction amongst suppliers.

In response, the Examiner (regarding claim 11) relies on Lustig's system comparing offers from database 270. The Examiner argues that by comparing available offers from a database "[Lustig's] matching engine conducts an auction amongst a plurality of vendors" (Examiner's Answer, pp 11-12). Lustig specifically teaches that matching database 270 "organizes, stores and retrieves information that describes a plurality of available offers made by one or more vendors" and that "matching database 270 can be the 'Order Book'" (Lustig, para. 56). One of ordinary skill in the art would not consider the comparison of offers in a database or "order book" as conducting an auction among suppliers. However, the Examiner fails to explain, even in response to Appellant's argument in the Appeal Brief, how merely comparing offers stored in a database can be considered conducting an auction. Lustig does not describe comparing the offers in matching database 270 as having anything to do with conducting an auction. Following the Examiner's logic, a person selecting an item out of a mail order catalog would also necessarily involve conducting an auction amongst all the suppliers in the catalog. The Examiner's interpretation is clearly incorrect.

While Seymour does disclose a “system and method for conducting an electronic auction over an open communications network,” **the Examiner fails to provide any reason at all as to why one of ordinary skill in the art would be motivated to combine the teachings of Seymour with the teachings of Lustig to create the specific method of claim 38.**

Thus, for at least the reasons presented above, the rejection of claim 38 is unsupported by the cited art and removal thereof is respectfully requested.

Claims 41 and 42

In regard to claim 41, Appellant has argued that **Lustig in view of Seymour fails to teach or suggest intercepting a message over the Internet to delay the purchase for a predetermined amount of time, wherein the message includes commitment to purchase information for the purchaser regarding the item or service.** The Examiner asserts that intercepting a message over the Internet to delay purchase for a predetermined amount of time, where the message includes commitment to purchase information is “well known in the art” and that it would have been obvious “to modify Lustig’s [system] in combining (sic) with Seymour ... for the purpose of providing more efficiency and convenient in communication over the Internet.” Applicants traverse the Examiner’s taking of Official Notice.

However, the Examiner has changed the subject which for he is taking Official Notice between the Final Action and the Examiner’s Answer. For instance, in the Final Action, the Examiner stated, “intercepting a message over the Internet, wherein the message includes commitment to purchase is well known in the art” (Final Action, p. 10). In the rejection listed in the Examiner’s Answer, the Examiner now argues that “intercepting a message over the Internet *to delay the purchase for a predetermined amount of time*, wherein the message includes commitment to purchase is well known in the art.” Thus, the Examiner has improperly introduced what is essentially a new ground

of rejection in the Examiner's Answer, without identifying it as a new ground of rejection.

Moreover, Appellant has argued throughout the prosecution of this case that the cited art does not teach the limitations of Appellant's claims, including claim 41. The Examiner has had ample opportunity to provide documentary evidence to support her taking of Official Notice, but has not done so.

Furthermore, Appellant has argued that the Examiner's assertion that intercepting a message over the Internet to delay the purchase for predetermined amount of time, where the message includes commitment to purchase is well known is merely the Examiner's opinion. **The Examiner hasn't cited any prior art that supports the Examiner's contention that it is obvious to intercept a message over the Internet where the message includes commitment to purchase information.**

Furthermore, M.P.E.P. 2144.03A clearly states, "It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." That is precisely the case here. The Examiner has merely stated that it is "well known in the art" to intercept a message over the Internet where the message includes commit to purchase information. The Examiner's assertion is the "principal evidence" upon which the rejection of Appellant's claim is based. Thus, the Examiner has not provided a proper taking of Official Notice.

Additionally, Appellant has argued that the Examiner's rejection does not take into account the full and complete language of Appellant's claim. The Examiner's rejection does not address the fact that claim 41 recites intercepting a message over the Internet *to delay the purchase for a predetermined amount of time*. Lustig and Seymour, as admitted by the Examiner do not mention anything regarding intercepting a message over the Internet to delay the purchase for a predetermined amount of time. The Examiner does not cite any prior art that teaches or suggests intercepting a message to delay a purchase for a predetermined amount of time. The

Examiner's combination of cited art thus fails to teach or suggest all claim limitations. M.P.EP. §2143.03 clearly states that all claim limitations must be taught or suggested by the prior art to establish *prima facie* obviousness. **The Examiner has failed to respond to this argument as prevented previously.**

Appellant has also argued that the Examiner has failed to provide a proper reason for modifying Lustig in view of Seymour. The Examiner has stated a general goal of improving the efficiency of Internet communication. The reason given by the Examiner would actually teach away from Appellant's claimed invention. One seeking to "provide more efficiency and convenience in Internet communication" would not be motivated to modify the combination of Lustig and Seymour to include intercepting a message over the Internet to delay a purchase for a predetermined amount of time, where the message includes commitment to purchase information. **The Examiner has failed to respond to this argument as prevented previously.**

Appellant has also argued that Lustig in view of Seymour fail to teach or suggest that if a better price is found before the predetermined amount of time expires, purchasing the particular item or service for the purchaser at the better price and charging the purchaser a new price between the particular price and the better price. The Examiner does not provide a proper rejection of claim 41. The Examiner merely states that claims "41, 42, and 44 contain similar limitations found in claims 1, therefore [claims 41, 42, and 44] are rejected by the same rational." **However, as argued in Appellant's Appeal Brief, claim 1 as well as the rejection of claim 1 fails to mention anything regarding purchasing an item or service for a purchaser at a better price and charging the purchaser a new price between the particular price and the better price.** The Examiner has improperly failed to consider the specific limitations of Appellant's claim. **Therefore, as noted in Appellant's appeal brief, no *prima facie* rejection has been stated in regard to claim 41. The Examiner has failed to respond to the argument as presented previously.**

In her response to arguments, the Examiner, without citing any portion of Lustig or Seymour in support, refers to the fact that Lustig's system may accept a better offer (than the user's originally selected offer) on behalf of the user. The Examiner then asserts, "Lustig obviously teaches purchasing the particular item [or] service for the purchaser that [at] the better price and charging the purchaser a new price between the particular price and the better." **However, the Examiner's assertion is completely unsupported by the actual teachings of the reference.** Nowhere does Lustig, even if viewed in light of Seymour, teach anything regarding purchasing the item for the purchaser at the better price and charging the purchaser a new price between the particular price and the better price. In fact, the very wording used by Lustig seems to teach away from charging the user a new price between price of Lustig's original offer and the price of a better offer. As admitted by the Examiner, Lustig teaches that his system, "accepts the better offer on behalf of the User" (para. 9, 15, 25, 19 and 81). Accepting a better offer *on behalf of the user* clearly implies that the better offer, and hence the cost or price of the better offer, is accepted by Lustig's system for the user. In contrast, Appellant's claim specifically recites charging the purchaser a new price between the particular price and the better price. Therefore, Lustig's system does not necessarily or inherently include or even suggest charging the user a price **between the original price and the better price**.

Claim 44

In regard to claim 44, Appellants have argued that **Lustig in view of Seymour fails to teach or suggest a plurality of broker-agent programs performing multiple searches in parallel for the better price**. In the Examiner's Answer, the Examiner states, "retrieving and comparing a plurality of available offers to determine the better offer is considered equivalent to performing multiple searches in parallel for better price", referring to Lustig's matching programming organizing, storing and retrieving a plurality of offers from a matching database. Appellant strongly disagrees. Lustig, even if combined with Seymour, does not teach a plurality of broker-agent programs performing multiple searches in parallel for the better price. The Examiner even states

that Lustig's matching program "organizes, stores, and retrieves a plurality of available offers *from a matching database*" (italics added). Thus, **as admitted by the Examiner**, Lustig teaches retrieving other offers from a database, not a plurality of broker-agent programs performing multiple searches in parallel. Offers may be obtained in order to fill a database in numerous ways. The Examiner's contention that retrieving a plurality of offers from a database is "equivalent to" performing multiple searches in parallel is simply incorrect and is clearly unsupported by the cited art.

Additionally, Lustig in view of Seymour fail to teach or suggest that if a better price is found before the predetermined amount of time expires, purchasing the particular item or service for the purchaser at the better price and charging the purchaser a new price between the particular price and the better price. The Examiner does not provide a proper rejection of claim 44. The Examiner merely states that claims "41, 42, and 44 contain similar limitations found in claims 1, therefore [claims 41, 42, and 44] are rejected by the same rational." **However, claim 1 as well as the rejection of claim 1 fails to mention anything regarding purchasing an item or service for a purchaser at a better price and charging the purchaser a new price between the particular price and the better price.** The Examiner has improperly failed to consider the specific limitations of Appellant's claim. **Therefore, no *prima facie* rejection has been stated in regard to claim 44.**

As noted above and argued in Appellant's Appeal Brief, Lustig in view of Seymour fails to teach or suggest purchasing the particular item or service for the purchaser at the better price and charging the purchaser a new price between the particular price and the better price. Lustig's system teaches only that the best offer found is accepted on behalf of the user. Nowhere does Lustig mention purchasing an item or service at a better price and charging the purchaser a new price between the particular price and the better price. Similarly, Seymour is silent regarding this limitation of Appellant's claim. Seymour's automated auction system allows buyers and sellers said to configure specific auction strategies that are implemented by bidder and seller agents. Nothing in Seymour's teaches or suggests purchasing the particular item or

service for the purchaser at the better price and charging the purchaser a new price between the particular price and the better price. Additionally, there is nothing about the Examiner's combination of Lustig and Seymour that teaches or suggests this limitation of Appellant's claim.

In her response to arguments, the Examiner, without citing any portion of Lustig or Seymour in support, refers to the fact that Lustig's system may accept a better offer (than the user's originally selected offer) on behalf of the user. The Examiner then asserts, "Lustig obviously teaches purchasing the particular item [or] service for the purchaser that [at] the better price and charging the purchaser a new price between the particular price and the better." **However, the Examiner's assertion is completely unsupported by the actual teachings of the reference.** Nowhere does Lustig, even if viewed in light of Seymour, teach anything regarding purchasing the item for the purchaser at the better price and charging the purchaser a new price between the particular price and the better price. In fact, the very wording used by Lustig seems to teach away from charging the user a new price between price of Lustig's original offer and the price of a better offer. As admitted by the Examiner, Lustig teaches that his system, "accepts the better offer on behalf of the User" (para. 9, 15, 25, 19 and 81). Accepting a better offer *on behalf of the user* clearly implies that the better offer, and hence the cost or price of the better offer, is accepted by Lustig's system for the user. In contrast, Appellant's claim specifically recites charging the purchaser a new price between the particular price and the better price. Therefore, Lustig's system does not necessarily or inherently include or even suggest charging the user a price **between the original price and the better price.**

CONCLUSION

For the foregoing reasons, it is submitted that the Examiner's rejection of claims 1-44 was erroneous, and reversal of the Examiner's decision is respectfully requested.

The Commissioner is authorized to charge the reply brief fee (small entity) of \$250.00 and any other fees that may be due to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5596-00301/RCK.

Respectfully submitted,

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